

### REMARKS/ARGUMENTS

Applicant has received the Office Action dated May 2, 2008, in which the Examiner rejected claims 1-10 under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Sismondi et al.* (U.S. Pat. No. 6,387,473, hereinafter "*Sismondi*") in view of *Miller* (U.S. Pub. No. 2002/0142141, hereinafter "*Miller*"). Applicants traverse the rejection for the following reasons.

In the Office Action, the Examiner takes the position that the additional surfactant disclosed by *Sismondi* (col. 7, ll. 43-61) meets the claimed nonsiloxane surfactant of claims 1-10. While acknowledging that *Sismondi* does not teach the use of siloxane surfactant, it is said that the SILWET L-7605 of *Miller* is substantially identical to Applicant's non-ionic siloxane surfactant of claims 2-5 and 7. It is said in the Office Action that it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the siloxane surfactant of *Miller* with the invention of *Sismondi* because *Miller* suggests improving handling and sheet feeding characteristics (paragraph [0049] of *Miller*). It is acknowledged in the Office Action that the relative amounts of the siloxane surfactant and the nonsiloxane surfactant are not taught by the references; however, the Examiner is of the opinion that one of ordinary skill in the art would have been motivated to adjust the relative amount of the siloxane surfactant and the nonsiloxane surfactant to control surface tension, wetting properties and glossiness of the layer.

Applicant respectfully submits that, if the person of ordinary skill in the art were to combine the non-ionic surfactant of *Sismondi* (col. 3, l. 31 - col. 4, l. 29) with an additional surfactant in the form of the siloxane surfactant disclosed by *Miller* (paragraph [0049]) in formulating the outermost layer of *Sismondi*, there would have been no reasonable expectation of success in achieving exactly the same composition as defined by any of claims 1-10. One reason is that, if the siloxane surfactant disclosed by *Miller* were combined with the ink jet receiving sheet of *Sismondi* for the purpose of improving handling and sheet feeding characteristics, there would have been no reasonable expectation that the resulting ink-receiving layer would necessarily contain a greater total amount of

siloxane surfactant than nonsiloxane surfactant, as required by claims 1–10. As disclosed by Applicants in paragraphs [0011], [0015] and [0036] of the specification, the claimed medium exhibits improved image quality and permanence. These qualities include improved mottle, haze, color gamut,  $K_{od}$ , lightfastness, humid bleed, and humid color shift, as stated in paragraph [0011], for example.

Militating against the proposed modification is the fact that *Sismondi* discloses numerous non-ionic surfactants (col. 3, l. 31–col. 4, l. 29) and appears to teach (col. 7, ll. 43–45) that the "additional surfactant" is other than non-ionic, specifically disclosing anionic surfactants, amphoteric surfactants and cationic surfactants. Accordingly, one of ordinary skill in the art, when attempting to improve the sheet handling and feeding characteristics of the *Sismondi* medium would be led by the teachings of *Sismondi* and *Miller* to select a cationic surfactant from those listed in paragraph [0049] of *Miller*, rather than selecting an additional non-ionic surfactant. To depart from the teaching of *Sismondi* regarding the properties of the "additional surfactants" would risk destroying the advantageous relationship between the outermost and underlying ink-receiving layers of *Sismondi* and the associated bleed, mottle and glossiness characteristics.

In the Office Action it is suggested that one of ordinary skill in the art would have been motivated to adjust the relative amount of the siloxane surfactant and the nonsiloxane surfactant to control surface tension, wetting properties and glossiness of the layer. Applicants respectfully submit that the skilled artisan would, at best, have been primarily motivated to optimize the relative amounts of the components to achieve the chief purpose of the proposed combination, *i.e.*, improving handling and sheet feeding characteristics. If one of ordinary skill in the art combined the siloxane surfactant of *Miller* with the nonsiloxane surfactant in the outermost later of *Sismondi* for the above-stated reason, and then endeavored to optimize the components with respect to improving handling and sheet feeding, and/or with respect to surface tension, wetting and glossiness properties, there would have been no reasonable expectation that the resulting

**Appl. No. 10/613,497**  
**Amdt. dated August 1, 2008**  
**Reply to Office Action of May 2, 2008**

product would necessarily have the same relative amounts of siloxane and nonsiloxane surfactants as specified in claims 1–10 because the relative amounts of siloxane and nonsiloxane surfactants would have been determined based on optimization of different parameters. Accordingly, optimization of the various parameters sought to be optimized in the modified layer of *Sismondi* would not necessarily have lead to the claimed composition. Applicant respectfully submits that claims 1–10 are non-obvious over the combination of *Sismondi* and *Miller*.

In the course of these discussions, Applicant may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the cited art which have yet to be raised, but which may be raised in the future.

Applicant respectfully requests reconsideration and withdrawal of the rejections, and that a timely Notice of Allowance be issued in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,

/Carol G. Mintz/

Carol G. Mintz  
PTO Reg. No. 38,561  
CONLEY ROSE, P.C.  
(713) 238-8000 (Phone)  
(713) 238-8008 (Fax)  
AGENT FOR APPLICANT

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
Legal Dept., M/S 35  
P.O. Box 272400  
Fort Collins, CO 80527-2400